

Appl. No.: 09/848,519
Amdt. dated 02/28/2007
Reply to Official Action of November 29, 2006

REMARKS/ARGUMENTS

This Reply is filed in response to the first Official Action for a Request for Continued Examination (RCE) of the above-identified patent application. The first Official Action no longer rejects all of the pending claims, namely Claims 1-20, under 35 U.S.C. § 103(a) as being unpatentable over the publication Susann Wilkinson, *Evaluation Report for Grant #R13 HG00793-0142: Impact of Human Genome Initiative on Society: A Women's Study Approach* (hereinafter "Wilkinson"). Instead, the Official Action rejects all of the pending claims as being unpatentable over the Wilkinson report in view of Official Notice of facts outside the record. As explained below, however, Applicant respectfully submits that the claimed invention is patentably distinct from Wilkinson; and as such, traverse the rejection of the claims as being unpatentable over Wilkinson. Noting that the Examiner has questioned the extent to which the recited characterizations affect the method of the claimed invention (or computer program product effectuating the method), however, Applicant has amended independent Claims 1, 7 and 15 to further recite the labeling of findings as part of the development of those findings, or including the presentation of the labels with the findings (as in computer program product Claim 7). In view of the amendments to the claims and the remarks presented herein, Applicant respectfully request reconsideration and allowance of all of the pending claims of the present application.

Again, Wilkinson discloses a participant evaluation of a workshop entitled "Women and Genetics in Contemporary Society" (WAGICS). As disclosed, the workshop was evaluated in a number of areas including participant background and expectations, pre- and post-workshop agreement with workshop goals, principles and procedures, assessment of the workshop's individual sessions and the alternative communication techniques, participants' post-workshop commentary and reflection. The evaluation data was collected via pre-and post-workshop participant questionnaires, on-site observations compiled on assessment sheets, and alternative communication techniques such as a suggestion/comment box. In one of the questionnaires, for example, a grid was presented on which participants indicated their agreement or disagreement with the theoretical principles that guided the process of organizing the meeting.

Appl. No.: 09/848,519
Amdt. dated 02/28/2007
Reply to Official Action of November 29, 2006

I. Claims 1-14 are Patentable over Wilkinson

According to one aspect of the claimed invention, as embodied in amended independent Claim 1, and similarly amended independent Claims 7 and 15, a method for assessing a process of an organization includes acquiring information concerning the organization and the process. A plurality of preliminary findings (see, e.g., FIG. 4, reference 26) is then developed based upon the information, where developing the plurality of preliminary findings includes characterizing and labeling each preliminary finding as a strength or weakness (see, e.g., FIG. 4, reference 30). Next, an electronic vote for agreement or disagreement with each preliminary finding is taken (see, e.g., FIG. 4, reference 32), or as recited in independent Claim 15, an electronic vote of agreement or disagreement with the characterization of each of the preliminary findings is then taken (see, e.g., FIG. 4, reference 34). Thereafter, a plurality of final findings is developed, where developing the plurality of final findings similarly includes characterizing and labeling each final finding as a strength or weakness. In this regard, the plurality of final findings is based upon the vote for the conclusion (or valuation in amended independent Claim 15) associated with each preliminary finding.

As explained in response to the final Official Action, in contrast to amended independent Claim 1, and similarly amended independent Claim 7, Wilkinson does not teach or suggest assessing a process of an organization according to a method that includes (a) developing preliminary findings based upon information concerning the organization and the process, including characterizing and labeling the findings as either a strength or weakness; (b) electronically voting for agreement or disagreement with each finding (or with the characterization of each finding); and then (c) developing final findings based upon the vote, including characterizing and labeling the final findings as a strength or weakness.

In the final Official Action, the Examiner appeared to allege that, although Wilkinson does not explicitly disclose preliminary or final findings having associated strength or weakness characterizations, this feature is inherent in Wilkinson since such characterizations are subjective and that, while the theoretical principles presented to the participants for agreement voting mostly include strengths, one or more of those principles may be viewed by some as weaknesses. Then, in the Advisory Action, the Examiner further explained that Applicant appeared to be

Appl. No.: 09/848,519
Amdt. dated 02/28/2007
Reply to Official Action of November 29, 2006

arguing that the aforementioned characterization is more akin to a label placed on a finding than an inherent subjective view of the finding, but that the claimed invention did not distinguish the two interpretations. In response thereto, Applicant amended independent Claims 1 and 7 to further recite that the preliminary and final findings are labeled with associated characterizations. Now, while the Examiner in the first Official Action concedes that Wilkinson does not teach or suggest findings including characterization labels, the Examiner takes Official Notice that it would have been obvious to label the alleged findings in Wilkinson with strength/weakness characterizations, the alleged motivation being to provide more information for the assessor to enable him/her to provide the most accurate assessment of the organization. Applicant respectfully disagrees, and separately addresses a number of deficiencies in the rejection of the claims below.

A. Acquisition of Information Concerning an Organization and Process

As to the claimed feature of acquiring information concerning an organization and process of the organization, Applicant respectfully submits that the Official Action fails to establish its inherency (as to the information concerning the organization and process) within Wilkinson. In addition, the Official Action appears to illogically assert its relationship with the disclosure of Wilkinson allegedly supporting the claimed feature of developing findings based upon that information.

I. Inherency of Acquiring Information Concerning an Organization and Process Thereof

Applicant also notes that, while the Examiner has not alleged that Wilkinson explicitly discloses evaluating of the principles of Table 3 (allegedly corresponding to the recited acquisition of information) to acquire information concerning the organization and the process, the Examiner alleges that the principles are inherently reflective of the organization and the process. Applicant respectfully submits, however, that not only has the Examiner not established inherency of the aforementioned feature of the claimed invention, Wilkinson does not inherently teach or suggest this feature. As disclosed in the MPEP, the Examiner bears the burden of

Appl. No.: 09/848,519
Amdt. dated 02/28/2007
Reply to Official Action of November 29, 2006

establishing inherency in the prior art. More particularly, as explained in the MPEP, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or in technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP § 2112 (*quoting Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). To establish inherency, evidence must make clear that the missing descriptive matter is necessarily present in the prior art, and would be recognized as being present in the prior art by those skilled in the art. "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999), *citing Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 1269 (Fed. Cir. 1991) (emphasis added).

In the instant case, the Examiner has failed to provide any facts or technical reasoning to support her conclusion that Wilkinson inherently discloses the aforementioned acquisition of information concerning both the organization and the process. And more particularly, the Examiner has failed to cite any supporting evidence to establish that evaluation of the principles of Table 3 necessarily result in the acquisition of information concerning both the meeting and ELSI (noting without admission that the Examiner has alleged that ELSI corresponds to the recited organization).

2. *Developing Preliminary Findings based upon Information Concerning an Organization and Process Thereof*

Applicant also notes that the Examiner has interpreted theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson, as corresponding to the plurality of preliminary findings of the claimed invention. Illogically, however, the Examiner has also interpreted the evaluation of those principles as corresponding to the recited acquisition of information concerning the organization and the process, as also recited by the claimed invention. In this regard, the claimed invention recites developing preliminary findings based upon acquired information concerning the organization and process, which implicitly requires the acquisition of information before development of the preliminary findings based thereon.

Appl. No.: 09/848,519
Amdt. dated 02/28/2007
Reply to Official Action of November 29, 2006

Under the Examiner's interpretation of the claimed invention and Wilkinson, however, Wilkinson discloses developing the principles of Table 3 (allegedly corresponding to the recited preliminary findings) based upon information acquired by evaluating the principles of Table 3 (allegedly corresponding to the recited acquisition of information). Obviously, the principles of Table 3 cannot be developed based upon information acquired by their evaluation since such an interpretation would circularly require the principles of Table 3 to be developed and evaluated to thereby acquire information from which the principles of Table 3 are developed.

B. Inherency of Strength/Weakness Characterizations

The Official Action appears to concede that Wilkinson does not explicitly disclose preliminary or final findings having associated strength or weakness characterizations. Nonetheless, the Official Action alleges that this feature is inherent in Wilkinson since such characterizations are subjective and that, while the theoretical principles presented to the participants for agreement voting mostly include strengths, one or more of those principles may be viewed by some as weaknesses. To the contrary, however, even if the principles disclosed by Wilkinson could have associated strength/weakness characterizations, this does not establish inherency of such characterizations in Wilkinson. Rather, establishing inherency of the aforementioned feature requires evidence establishing that principles necessarily do include such characterizations, as opposed to a probability or possibility of including those characterizations.

In response to the foregoing, the final Official Action maintains that Wilkinson does inherently disclose strength/weakness characterizations of the principles presented to the participants for agreement. Nonetheless, the Official Action still fails to establish this inherency. As disclosed in the MPEP, the Examiner bears the burden of establishing inherency in the prior art. More particularly, as explained in the MPEP, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or in technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP § 2112 (*quoting Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)).

Appl. No.: 09/848,519
Amdt. dated 02/28/2007
Reply to Official Action of November 29, 2006

In the instant case, the Examiner has failed to provide any facts or technical reasoning to support her conclusion that Wilkinson inherently discloses the aforementioned strength/weakness characterizations. The Examiner does allege that most of the principles are characterized as inherent strengths. But not only does the Examiner fail to provide facts or technical reasoning for her conclusion that most of the principles are inherently characterized as strengths, but her allegation does not support that the principles inherently include strength/weakness characterizations in the first place. In fact, in the only substantive attempt to provide such reasoning to support the inherency of characterizations, proffered in the second Official Action (see page 3), the Examiner's explanation clearly demonstrated that the principles of Wilkinson do not necessarily, and thus inherently, include associated strength/weakness characterizations, similar to the claimed invention.

In contrast to the allegation of the Official Action, Applicant respectfully submits that nothing in Wilkinson teaches or suggests, explicitly or inherently, that the items of the participant questionnaires are characterized as strengths or weaknesses (i.e., have associated characterizations selected from a group consisting of a strength or a weakness), as recited by the claimed invention. As is well understood by those skilled in the art, characterizations such as those recited by the claimed invention may be considered traits, qualities or properties that at least partially distinguish respective entities from one another. See Merriam-Webster Online Dictionary, *Characteristic* (visited Feb. 27, 2006) <<http://www.m-w.com/dictionary/characteristic>> (explaining that characteristics may be defined as distinguishing traits, qualities or properties). In accordance with the claimed invention, then, the recited characterizations at least partially distinguish the findings from one another. Nothing in Wilkinson, however, teaches or suggests that the items of a questionnaire have associated traits, qualities or properties that serve to distinguish the items from one another, much less in any manner that could reasonably be interpreted to correspond to a strength or a weakness.

Applicant therefore respectfully submits that independent Claim 1, and similarly independent Claim 7, is patentably distinct from Wilkinson. And as dependent Claims 2-6 and 8-14 include all the limitations of respective ones of independent Claims 1 and 7, dependent Claims 2-6 and 8-14 are also patentably distinct from Wilkinson for at least the reasons given

Appl. No.: 09/848,519
Amdt. dated 02/28/2007
Reply to Official Action of November 29, 2006

above. In addition, Applicant respectfully submits that various ones of dependent Claims 2-6, 8-14 and 16-20 recite features further patentably distinct from Wilkinson. For example, dependent Claim 6, and similarly dependent Claim 12, further recites voting for agreement or disagreement with the characterization (strength or weakness) of each preliminary finding (i.e., voting for a valuation), and developing final findings further based upon the aforementioned voting step. As explained above, Wilkinson does not teach or suggest, explicitly or inherently, preliminary or final findings having associated strength or weakness characterizations. Thus, Wilkinson also does not teach or suggest, explicitly or inherently, voting for agreement or disagreement with those characterizations. Moreover, even if one could argue (albeit incorrectly) that Wilkinson inherently discloses that the questionnaire items are inherently characterized as strengths or weaknesses by virtue of the subjective nature of such a characterization, Wilkinson still does not teach or suggest voting for agreement or disagreement with the characterization of findings as strengths or weaknesses, as recited by dependent Claims 6 and 12.

C. Improper Official Notice

The Official Action concedes that Wilkinson does not teach or suggest labeling the theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson (allegedly corresponding to preliminary/final findings) with strength/weakness characterizations, similar to the findings of the claimed invention. Nonetheless, the Official Action takes Official Notice that one skilled in the art would have found it obvious to modify Wilkinson to include this feature, with the alleged motivation being to provide more information for the assessor to enable him/her to provide the most accurate assessment of the organization. Applicant respectfully disagrees and, not only traverses the taking of Official Notice, but the allegation that one skilled in the art would have been motivated to modify Wilkinson, to enable the most accurate assessment.

According to MPEP § 2144.03(A.), Official Notice can only be taken of facts that are "capable of instant and unquestionable demonstration as being well-known." Citing *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), the MPEP continues by explaining that "the notice of facts beyond the record which maybe taken by the examiner must be 'capable of such instant and

Appl. No.: 09/848,519
Amdt. dated 02/28/2007
Reply to Official Action of November 29, 2006

unquestionable demonstration as to defy dispute.” Applicants respectfully submit that the Official Action did not, in fact, take Official Notice of facts capable of instant and unquestionable demonstration as being well known so as to defy dispute. If, as alleged (but expressly not admitted), the theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson (allegedly corresponding to preliminary/final findings) inherently reflect their characterizations as strengths/weaknesses, then those principles must necessarily reflect their characterizations (see above as to the requirement for properly asserting an inherent disclosure). If the principles necessarily reflect their characterizations, as alleged (but expressly not admitted), one could argue that those skilled in the art could just as easily interpret the inherently-reflected characterizations without labels identifying those characterizations, contrary to the Official Notice taken by the Examiner.

Thus, the Official Action has taken Official Notice that it would have been obvious to label the theoretical principles of Table 3 of Wilkinson with their inherently-reflected strength/weakness characterizations. Applicant respectfully submits, however, that it is equally plausible that if the theoretical principles inherently reflect strength/weakness characterizations, as alleged (but expressly not admitted), one skilled in the art could interpret those characterizations without any labels identifying those characterizations. Therefore, Applicant respectfully submits that the assertion that it would have been obvious to label the theoretical principles of Table 3 of Wilkinson with their inherently-reflected strength/weakness characterizations is not capable of instant and unquestionable demonstration as being well known so as to defy dispute, as required to take Official Notice of facts not in the record.

D. No Motivation to Modify Wilkinson

Although the Official Action alleges that the theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson (allegedly corresponding to preliminary/final findings), inherently reflect strength-weakness characterizations, the Official Action alleges that would have been obvious to one skilled in the art to label the principles with their characterizations to “provide more information for the assessor to enable him or her to provide a most accurate assessment of the organization.” Official Action of November 29, 2006,

Appl. No.: 09/848,519
Amdt. dated 02/28/2007
Reply to Official Action of November 29, 2006

page 4. Applicant respectfully disagrees, and respectfully submits that one skilled in the art would not have been motivated to modify Wilkinson to include characterization labels.

As explained above, if the principles necessarily reflect their characterizations, as alleged (but expressly not admitted), one could argue that those skilled in the art could just as easily interpret the inherently-reflected characterizations without labels identifying those characterizations. In other words, if the theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson (allegedly corresponding to preliminary/final findings) inherently reflect their characterizations as strengths/weaknesses, why would one skilled in the art need or even desire to further label those principles with their respective characterizations. More particularly, borrowing the example in the Official Action, if the principle, "suggested reading were useful in accomplishing workshop goals," inherently conveys a strength, as alleged (but expressly not admitted), why would one skilled in the art need or desire for the principle to include a label expressly identifying the usefulness of suggested reading as a strength.

For at least the foregoing reasons, Applicant respectfully submits that amended independent Claim 1 and similarly amended independent Claim 7, and by dependency Claims 2-6 and 8-14, are patentably distinct from Wilkinson. Thus, Applicant also respectfully submits that the rejection of those claims as being unpatentable over Wilkinson is overcome.

II. Claims 15-20 are Patentable over Wilkinson

Similar to amended independent Claim 1, independent Claim 15 recites a method for developing at least one assessment of a process of an organization, where each of the at least one assessments has an associated characterization selected from a group consisting of a strength and a weakness. Also similar to amended independent Claim 1, amended independent Claim 15 recites acquiring information concerning the organization and the process, and developing a plurality of preliminary findings based upon the information, where developing the plurality of preliminary findings includes characterizing and labeling each preliminary finding with an associated strength/weakness characterization. In addition, similar to dependent Claim 6, independent Claim 15 recites voting for a valuation associated with each preliminary finding,

Appl. No.: 09/848,519
Amdt. dated 02/28/2007
Reply to Official Action of November 29, 2006

where the valuation is selected from a group consisting of an agreement with the characterization of the preliminary finding and a disagreement with the characterization of the preliminary finding. Further, independent Claim 15 recites developing the assessment(s), where developing the assessment(s) includes characterizing and labeling each assessment with an associated characterization based upon the voting for the valuation associated with each preliminary finding.

In contrast to independent Claim 15, Wilkinson does not teach or suggest assessing a process of an organization according to a method that includes developing preliminary findings based upon information concerning the organization and the process, where each finding is characterized as either a strength or weakness, as explained above with respect to independent Claim 1. Also in contrast to independent Claim 15, Wilkinson does not teach or suggest voting for agreement or disagreement with strength or weakness characterizations of the preliminary findings. As to the similar subject matter of dependent Claim 6, the Official Action alleges that Wilkinson discloses voting for agreement/disagreement with the theoretical principles of Table 3 and their inherent characterizations. Applicant again respectfully submits, however, that Wilkinson does not in fact inherently (or explicitly) disclose strength/weakness characterizations for the theoretical principles of Table 3. And even further, Wilkinson does not teach or suggest voting for agreement/disagreement with strength/weakness characterizations for the theoretical principles of Table 3 (even if one could argue that the principles inherently include strength/weakness characterizations – although, yet again, expressly not admitted).

Thus, for at least the same reasons given above with respect to independent Claim 1, and for the additional reason given immediately above, Applicant respectfully submits that amended independent Claim 15, and by dependency Claims 16-20, is also patentably distinct from Wilkinson. Accordingly, Applicant respectfully submits that the rejection of Claims 15-20 as being unpatentable over Wilkinson is overcome.


Appl. No.: 09/848,519
Amdt. dated 02/28/2007
Reply to Official Action of November 29, 2006

CONCLUSION

In view of the amendments to the claims and the remarks presented above, Applicant respectfully submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

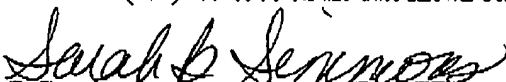


Andrew T. Spence
Registration No. 45,699

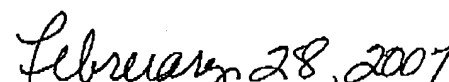
Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

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Sarah B. Simmons



February 28, 2007
Date

LEGAL01/13030490v1